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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,390	08/21/2003	Mitinori Saitou	DKA-33545	1543

56080 7590 05/11/2006

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EXAMINER

GAMETT, DANIEL C

ART UNIT PAPER NUMBER

1647

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/646,390	<b>Applicant(s)</b> SAITOU ET AL.	
	<b>Examiner</b> Daniel C. Gamett, PhD	<b>Art Unit</b> 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02/21/2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 7-22, 24, 25 and 28-54 is/are pending in the application.
- 4a) Of the above claim(s) 8-22, 25 and 28-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 7-22, 24, 25 and 28-54 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/21/2006</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The amendments of 02/21/2006 have been entered in full. Claims 2-6, 23, 26, and 27 are cancelled. Claims 8-22, 25, and 28-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Claims 1,7, and 24 are under examination.
2. All prior objection/rejections not specifically maintained in this office action are hereby withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

#### ***Claim Rejections Maintained***

##### ***35 USC § 112***

4. Rejection of claims 1,7, and 24 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is maintained. The amended claims are drawn to a genus of polypeptides that is defined only by sequence identity. There is no identification of any particular portion of the structure that must be conserved, nor any functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof, such that the single disclosed species could provide adequate written description of the claimed genus.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayzer *et al.*, Gene 117 (1992), 277-278, of record. The instant specification indicates a preference for expressing homology in terms of sequence identity, but also acknowledges that homology can be considered in terms of similarity (page 16, lines 22-25). The alignment of SEQ ID NO: 2 and PIR accession number JC1241 provided with the rejection under 102(b) of record indicates a query match of 92.3%. This is a measure of similarity that takes conservative substitutions into account. If the 8 conservative substitutions were weighted equally with exact matches, the overall similarity would be 131/137 or 95.6%. Thus it is clear that the sequence of JC1241 is at least 90% similar to SEQ ID NO: 2, thereby meeting the homology limitation of claim 1. Hayzer *et al.* did not disclose an isolated polypeptide as required by the amended claim. The sequence information disclosed by Hayzer *et al.* would make isolation of the JC1241 protein obvious to one of skill in the art. Hayzer *et al.* further identified the JC1241 protein as being a member of a multigene family of considerable interest because of their inducibility by interferon, thus providing a motivation to isolate the protein as a step in its characterization.

### *Conclusion*

7. No claims are allowed.

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8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel C Gamett, Ph.D., whose telephone number is 571 272 1853. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571 272 0961. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCG  
Art Unit 1647  
4 May 2006

  
**DAVID S. ROMEO**  
**PRIMARY EXAMINER**